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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/070,532 | 07/19/2002 | Daniel R. Soppet | PF168P3 | 5548 |

22195 7590 08/09/2005

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EXAMINER

LOCKARD, JON MCCLELLAND

ART UNIT PAPER NUMBER

1647

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,532

Applicant(s)

SOPPET ET AL.

Examiner

Jon M. Lockard

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 and 26-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 11 and 26-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application, Amendments, and/or Claims

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1647, Examiner Jon Lockard.

Election/Restrictions

2. Applicants newly filed claims are drawn to numerous patentably distinct amino acid sequences. Thus, further restriction *within* the formerly presented Invention IV is required under 35 U.S.C. 121, as follows:

The claims are drawn to numerous patentably distinct amino acids, each of which constitutes a patentably distinct product. Applicant is required to elect a single invention of a amino acid, selected from the Group consisting of (i.e. elect one from the following Markush groups): a protein comprising an amino acid sequence selected from the group of sequences encoded by ATCC Deposit No: 97128 consisting of the following regions of SEQ ID NO: 2 or 6:

- IV-A. amino acid residues 1-46 of SEQ ID NO: 2
- IV-B. amino acid residues 47-72 of SEQ ID NO: 2
- IV-C. amino acid residues 73-82 of SEQ ID NO: 2
- IV-D. amino acid residues 83-106 of SEQ ID NO: 2
- IV-E. amino acid residues 112-142 of SEQ ID NO: 2
- IV-F. amino acid residues 163-189 of SEQ ID NO: 2
- IV-G. amino acid residues 190-213 of SEQ ID NO: 2
- IV-H. amino acid residues 335-363 of SEQ ID NO: 2
- IV-I. amino acid residues 364-402 of SEQ ID NO: 2
- IV-J. amino acid residues 364-372 of SEQ ID NO: 6

IV-K. amino acid residues 1(2)-425 of SEQ ID NO: 2

3. Applicants should note that in some cases multiple claims encompass one of the patentably distinct inventions set forth herein. To be fully responsive to this requirement, Applicants are **required** to point out which claims correspond to the elected invention.

4. Although the classifications for these various amino acid sequences are overlapping, for instance 530/350, each represents a patentably distinct product with distinct physical and functional characteristics. Further the search for more than one product would be burdensome, because each search for a portion of a disclosed amino acid sequence requires a separate and non-coextensive “word search” of the amino acid databases. Due to the use of ‘comprising’ language, it cannot even be said that the search for amino acids encoding amino acids 1 to 425 of SEQ ID NO: 2 would reveal art pertaining to, for instance, an amino acid sequence *comprising* amino acids 73 to 82 of SEQ ID NO: 2, as the latter could be found embedded in a completely different protein. Accordingly, restriction is proper.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(i).

Art Unit: 1647

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jon M. Lockard, Ph.D.** whose telephone number is (571) 272-2717. The examiner can normally be reached on Monday through Friday, 8:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Brenda Brumback**, can be reached on (571) 272-0961.

The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JML

August 4, 2005

Bridget E. Bunner

**BRIDGET BUNNER
PATENT EXAMINER**